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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,341	10/11/2000	Peter Jenkner	198277US0 DIV	7038

22850 7590 07/16/2002

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/16/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-10

# Office Action Summary

Application No.

09/685,341

Applicant(s)

JENKNER ET AL

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 06 June 2002.

2a) ☒ This action is **FINAL**.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 23-38 is/are pending in the application.

4a) Of the above claim(s) 31-38 is/are withdrawn from consideration.

5) ☒ Claim(s) 29 and 30 is/are allowed.

6) ☒ Claim(s) 23-28 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 08/984162.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

### ***Election/Restrictions***

This application contains claims 31-38 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al., U.S. Patent # 5,489,328 for the reasons set forth in paper no. 7.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamizawa et al., U.S. Patent # 4,024,306 for the reasons provided in paper no. 7.

### ***Response to Arguments***

The Applicants traverse the aforementioned rejections on the following grounds:

(i) the Examiner has misinterpreted the end-result of the fluorinated organosilicon preparation process outlined in each of the independent claims. In particular, whereas the Examiner has concluded that the controlled hydrolysis step that is carried out in an alcohol medium in the presence of an acidic- or alkaline catalyst yields a fluorinated polysiloxane that is, in turn, coated onto a surface to render said surface hydrophobic/oleophobic, the material that is coated onto a surface is actually a

solution of the fluorinated organosilane precursor. That is, the hydrolysis process does not lead to polymerization of the silane but, rather, only creates groups that may be reacted with a surface to form what is sometimes termed a monomolecular film.

(ii) Ono and Takamizawa both teach the formation of hydrophobic films comprising not only the fluorinated organosilane but also other hydrolyzable silane compounds. By contrast, Applicants' method employs solely a fluorinated organosilane *to the exclusion of all other silane compounds.*

As for the first issue, the Applicants' current position that that the method of hydrophobizing entails coating a surface with discrete monomeric silane compounds is in direct conflict with the language they have used to describe their own invention. The claim is directed to, "a method of hydrophobizing and oleophobicizing... by applying to such a fluoroalkyl-functional group-containing organosiloxane-based composition...". Also, according to the Specification at page 4, lines 10-15, said organosiloxane compositions are available as homogeneous, clear solutions that are stable for several months. Based on these passages taken from the disclosure, it would appear that the Examiner's earlier interpretation was correct. In fact, the Applicants' contentions regarding the claimed method, as provided in their response, are entirely inconsistent with the language used throughout the original Specification and claims.

Concerning the second point, claims 23, 25, and 27 in no way prohibit the utilization of compounds aside from the fluoroalkyl-functional group-containing organosilanes depicted in formulae Ia and Ib for preparing the fluoroalkyl-functional

group containing organosiloxane-based composition that imparts the hydrophobic/oleophobic properties to a surface. (It is noted that no closed-ended language such as, for instance, "consisting of" is employed anywhere in Applicant's description of the process of making the fluoroalkyl-functional group containing organosiloxane coating material.) Indeed, these claims require only that one of the silanes involved in the formation of the fluoroalkyl group-containing organosiloxane adhere to Ia or Ib. Unquestionably, the organosiloxane coating products taught by Ono and Takamizawa will feature fluoroalkyl substituents insofar as they incorporate as one of the starting materials a silane that obeys the structural requirements of Ia or Ib. Hence, it would appear that all limitations of the claims are presently satisfied.

***Allowable Subject Matter***

Claims 29 and 30 are allowed. Applicant has adequately addressed the rejections under 35 USC 112, second paragraph raised in the previous Office action. Accordingly, claims 29 and 30 are now allowable as the prior art does not contemplate treating a filler with siloxane polymers derived from either silane Ia or Ib.

It should be stated for the record that the Examiner had inadvertantly designated claim 28 as being rejected under 35 USC 103 (a) and, at the same time, potentially allowable pending Applicants' amendment to remedy the aforementioned 112 rejections. However, it is clear from the Examiner's reasons for allowability that claims 29 and 30 should have been indicated since claim 28 does not mention the treatment of filler.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

July 9, 2002



Robert Dawson  
Supervisory Patent Examiner  
Technology Center 1700